

Atty Dkt. No.: CLON-035CIP
USSN: 10/006,922

REMARKS

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 1-23, 27 and 31, the only claims pending and currently under examination in this application, Claims 24 to 25 and 29 having been canceled and Claims 26, 28 and 30 having been withdrawn from further consideration.

Claims 6, 7, 11, 16, 18 and 20 have been amended to adopt the Examiner's suggestion. As the above amendments introduce no new matter to the application, their entry by the Examiner is respectfully requested.

It is noted that the above amendments have been made solely in order to expedite allowance of the present application, and should in no way be construed as an acquiescence by the Applicants with the Office with respect to any rejection appearing in the Office Action. The Applicants expressly reserve the right to pursue the claims of their original scope and format in a continuation application.

An objection has been raised against Claims 6, 7, 11 and 16-21. In view of the above amendments to these claims, this objection may be withdrawn.

Claims 1-23, 27 and 31 have been rejected under 35 U.S.C. § 102(e) over Lukyanov et al., WO 00/34326.

It is first noted that this reference was actually published on June 15, 2000. It is only a reference as of its publication date since the application was filed prior to November 29, 2000.

The present application is fully entitled to its claimed priority to application serial no. 09/210,330 filed on December 11, 1998. See the filed declaration by the inventors, of record. As such, Lukyanov et al., WO 00/34326 does not qualify as prior art to the present application because Lukyanov et al., WO 00/34326 has a publication date of June 15, 2000, over 1 year later than the priority date of the present application.

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Because Lukyanov et al., WO 00/34326 does not qualify as prior art to the present application, the rejection of Claims 1-23, 27 and 31 under 35 U.S.C. § 102(b) over Lukyanov et al., WO 00/34326 may be withdrawn.

Finally, Claims 1-23, 27 and 31 have been rejected under either 35 U.S.C. § 102(e), or alternatively under 35 U.S.C. § 103(a) over Tsien et al., U.S. Patent No. 6,342,379.

The 6,342,379 patent was filed as application serial no. 09/459,956 on December 13, 1999. While the patent claims priority to an earlier application, i.e., "U.S. Pat. Ser. No. 08/765,860, now U.S. Pat. No. 6,107,066 filed May 8, 1997," the subject matter upon which the Examiner relies in making this rejection first appeared in the application filed on December 13, 1999. Specifically, the Examiner bases the rejection on Table 2, seq id no: 5 and seq id no. 6. A search of the parent 08/765,860 application finds this disclosure absent. In fact, there are no tables or sequence ID Nos. at all in the 08/765,860 application. As such, this disclosure first appeared in the December 13, 1999 filing. Accordingly, the cited Tsien patent has a 102(e) date of on December 13, 1999.

As pointed out above, the present application is fully entitled to its claimed priority to application serial no. 09/210,330 filed on December 11, 1998. See the filed declaration by the inventors, of record. As such, U.S. Patent No. 6,342,379 patent does not qualify as prior art to the present application because U.S. Patent No. 6,342,379 has a 102(e) date for the subject matter relied upon by the Examiner of over 1 year later than the priority date of the present application.

Because U.S. Patent No. 6,342,379 does not qualify as prior art to the present application, the rejection of Claims 1-23, 27 and 31 under 35 U.S.C. § 102(b) over U.S. Patent No. 6,342,379 may be withdrawn.

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CONCLUSION

In view of the above remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815.

Respectfully submitted,

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